REMARKS

Pending claims

For the record, Applicants canceled claims 2-10, 13-29, 46-70 and 72-107 on the Transmittal Sheet for this application. Applicants address in this Response to Restriction Requirement only the Groups which contain pending claims.

The Preliminary Amendment

For the record, Applicants note that the amendment to the paragraph beginning at page 26, line 23 and ending on page 27, line 2, in the Preliminary Amendment, which corrected the reference to SEQ ID NO:42 (instead of the typographical error referencing SEQ ID NO:43) is fully supported in the specification as filed. In particular, it is noted that SEQ ID NO:42 corresponds to SEQ ID NO:12 of priority application USSN 60/144,270, filed July 15, 1999, which was incorporated by reference. The specification of '270 discloses on page 16, lines 23-24 that "SEQ ID NO:12 is expressed specifically in islet cells and in islet cell tumor only." It is further noted that in the Sequence Listing for the '270 application, SEQ ID NO:12 is indicated as being derived from "<223> Incyte Clone No: 5037143," which is the same clone from which SEQ ID NO:42 of the instant application was derived. Therefore, rectification of this error is obvious, and does not introduce any new matter.

Response to Restriction Requirement

Applicants hereby elect to prosecute the claims of Group LIV, claims 11, 31-32, 34 and 36-43, drawn to antibodies which specifically bind to a polypeptide of SEQ ID NO:16, with traverse. Applicants reserve the right to prosecute the subject matter of non-elected claims in continuation and/or divisional applications.

Applicants traverse the restriction at least upon the grounds that it is unduly multiplied. In addition, Applicants traverse the restriction on the grounds that the Examiner should, upon allowance of the antibody product claims, rejoin the claims to methods of use thereof and methods of making them which are of the same scope as the allowed product claims, specifically the claims of

- Group CXIX (claim 30, drawn to a diagnostic test using an antibody that specifically binds to a polypeptide of SEQ ID NO:16);

- Group CXX (claims 33 and 35, drawn to methods of diagnosing a disease or condition using an antibody that specifically binds to a polypeptide of SEQ ID NO:16);
- Group CXXI (claim 44, drawn to a method of detecting a polypeptide of SEQ ID NO:16 using an antibody); and
- Group CXXII (claim 45, drawn to a method of purifying a polypeptide of SEQ ID NO:16 using an antibody).

See, e.g., the Commissioner's Notice in the Official Gazette of March 26, 1996, entitled "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai, In re Brouwer* and 35 U.S.C. § 103(b)" which sets forth the rules, upon allowance of product claims, for rejoinder of process claims covering the same scope of products. Applicants remind the Examiner of his duty to rejoin, upon allowance of the product antibody claims, the method claims which are directed to methods of making or using the claimed antibody products, wherein the method claims are directed to the use of antibodies having the same scope as the allowed antibody products.

In addition, Applicants respectfully submit that any proper search for antibodies that bind specifically to a polypeptide of SEQ ID NO:16 will necessarily encompass a search for the polypeptide itself, variants and fragments thereof, and polynucleotides encoding the polypeptide. Therefore, Applicants submit that it would be far less of a burden, and certainly not an undue burden, for the Examiner to extend his search and examination to the pending claims of Group XVI and XLII as compared with the Applicants' burden to file, prosecute and maintain 184 patents.

For the record, in addition to encompassing claims which were not pending, it is noted that the Restriction Requirement contained numerous errors in setting forth the claims of the restricted groups; e.g., every one of the first 26 Groups included claim 1, which should only have been included in Group XVI, as well as the second 26 Groups (XXVII-LII), which included claims 4, 5, 9 and 10, which claims only recite a polynucleotide of SEQ ID NO:42 and thus should only have been in Group XLII.

Preliminary comments regarding utility

For the record, the Examiner's attention is directed to, *inter alia*, at least one of the disclosed specific, substantial and credible uses of the polypeptide of SEQ ID NO:16, the polynucleotide of

SEQ ID NO:42, as well as antibodies which specifically bind to the polypeptide of SEQ ID NO:16, which use is disclosed in the paragraph bridging page 26, line 23 to page 27, line 2, as amended in the Preliminary Amendment. In particular, as noted therein, the polynucleotide of SEQ ID NO:42 "is expressed specifically in islet cells and in islet cell tumor only" and is therefore a tissue-specific marker. Therefore, the polypeptides and antibodies thereto are similarly useful as tissue specific markers and in methods for identifying these tissues.

Applicants believe that no fee is due with this communication. However, if the USPTO determines that a fee is due, the Commissioner is hereby authorized to charge Deposit Account No. 09-0108.

Respectfully submitted,

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